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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,082	12/06/2001	Dimitri Charrette	111387	5354

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EXAMINER

MILLER, EDWARD A

ART UNIT	PAPER NUMBER
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3641

DATE MAILED: 12/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Applicant No. 10/003,082	Applicant(s) CHARRETTE ET AL.	
	Examiner Edward A. Miller	Art Unit 3641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-14 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3641

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-9, drawn to a composition, classified in class 149, subclass 19.2.
 - II. Claims 10-14, drawn to a process, classified in class 264, subclass 3.1+.
2. The inventions are distinct, each from the other because of the following reasons:
3. Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the method of Group II, notwithstanding the terms of the claim 10, does not make the composition of Group I. Group II makes a solid, unitary, extruded propellant. Group I as claimed is not an extrudate, but a composition, per se, without physical form. It can be made by mixing, without extrusion.
4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).
6. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for examination purposes, even though this requirement is traversed. The single species shall be a single composition of the binder ingredients, that is the two components of claim 1 and the curing agent as appropriate. Related search is required in various subclasses of class 149, not to mention other possibilities in other (polymer or composition) classes, depending on these details, and thus this requirement is based upon PTO policy regarding undue breadth, and or Markush terminology, MPEP 809.02(d) and 803.02. . Claims 1-14, as best understood, are generic.

Art Unit: 3641

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Throughout the claims, terms are used which cannot reasonably be understood. In claim 1, line 5, "hydrocarbonaceous binder" is recited, but of the possibilities recited therein, polyester or acrylic, claim 1, lines 8-11, neither are hydrocarbonaceous. While applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). The term "hydrocarbonaceous" is

Art Unit: 3641

used in the claim as generic (the particular nature of which is, however, not clear), while the accepted meaning is "having a hydrocarbon-like nature." This term is properly applied in context to, for example, hydroxy terminated polybutadiene, styrene-butadiene rubbers, and so on, which are essentially hydrocarbon in nature. According to the Merriam-Webster online dictionary, Main Entry: "-aceous": Function: adjective suffix, Etymology: Latin -aceus 1 a : characterized by, full of <setaceous> b: consisting of <diatomaceous>, having the nature or form of <tuffaceous>. According to standard chemical definitions, hydrocarbons consist only of carbon and hydrogen, as is notoriously well known. Thus, whatever applicants may have intended, as used the meaning is repugnant to the ordinarily used meaning. Further, the two examples of the "gum" are not understood as being a "gum", as this term is properly understood. It is not understood what the two supposed components of the binder are supposed to be by type. Even if the first type were correctly characterized as a gum (although this is not believed correct), the second component is either a resin or a plasticizer. This makes no logical sense, as a category, as there is no correspondence of the two examples. Is it applicants' intent that the second component may be any type of binder component?

In claim 10, line 5, there is no antecedent basis for "the solid (A) and liquid(B) constituents" and in line 9, there is no antecedent basis for "the homogeneous paste thus formed".

Claim 10 is object to since a process does not further limit a composition, and this apparently constitutes a single claim encompassing a plurality of classes of invention, as it recites method steps, and further limits a composition as set forth and thus must be a composition claim. As set forth in *Ex parte Lyell* (BdPatApp&Int) 17 USPQ2d 1548, "a claim which is intended to embrace both product or machine and process is precluded by language of 35 USC 101, which sets forth statutory classes of invention in alternative only, and is also invalid under 35 USC 112, second

Art Unit: 3641

paragraph, since claim which purports to be both machine and process is ambiguous and therefore does not particularly point out and distinctly claim subject matter of invention.” In like manner, claim 1 recites a composition, but also method steps of “it is used”, lines 8 and 10.

Further, claim 3 is conditional, and it is indefinite as to whether anything is positively required by this claim or not. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical, idiomatic and patent law errors.

9. The claims are so indefinite, that they cannot reasonably be examined as to prior art at this time. It has been held improper, indeed, reversible error, to rely on speculation as to the meaning of indefinite claims, and then reject that speculative meaning on prior art. *In re Steele*, 305 F.2d 858, 134 USPQ 292 [CCPA 1962], *Ex parte Brummer*, 12 USPQ2d 1653 at 1655 [USPTO BOPAI 1989].

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Note paragraph 8 above. It is not clear that applicant has properly disclosed what the invention is, or enabled the ordinary artisan to make and use it, as to the polymer details therein. The language used is so vague, and not in accord with standard usage that it appears that the specification does not teach how to adequately practice the invention.

Art Unit: 3641

12. In the applicants' cited references, a Chemical Abstract dated more than one year prior to applicants' US filing date is cited which appears to be particularly relevant, and that was apparently co-authored by employees of assignee. Applicants are required to supply a copy of the original document, absent good reason such as undue length, when a pertinent part will suffice. See MPEP 2004, for example, Item 5.

13. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

14. The abstract of the disclosure is objected to because it is not in proper form. Correction is required. See MPEP § 608.01(b).

15. New corrected drawings are required in this application because the drawings contain rough, blurred lines, not straight, clear, solid black lines, in accordance with 37 CFR 1.84 and 1.85.

Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

16. The specification is objected to for lack of a brief description of the drawings, which

Art Unit: 3641

applicant is required to provide. Note 37 CFR § 1.74, Reference to drawings.

When there are drawings, there shall be a brief description of the several views of the drawings and the detailed description of the invention shall refer to the different views by specifying the numbers of the figures and to the different parts by use of reference letters or numerals (preferably the latter).


17. The disclosure is objected to because of the following informalities: There are no section heading, and compliance with other standard US practice in the format of the specification is lacking. Appropriate correction is required, in accordance with US rules including 37 CFR 1.121.

18. Any inquiry concerning either this or an earlier communication from the Examiner should be directed to Examiner Edward A. Miller at (703) 306-4163. Examiner Miller may normally be reached Monday-Thursday, from 10 AM to 7 PM.

If attempts to reach Examiner Miller by telephone are unsuccessful, his supervisor Mr. Carone can be reached at (703) 306-4198. The Group fax number is (703) 305-7687.

If there is no answer, or for any inquiry of a general nature or relating to the application status, please call the Group receptionist at (703) 308-1113.

Miller/em
December 14, 2002



EDWARD A. MILLER
PRIMARY EXAMINER